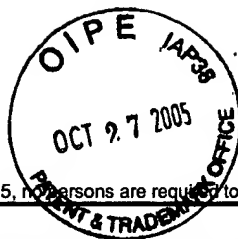


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

101216-09002

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

09/393,576

Filed

September 10, 1999

First Named Inventor

ENOMOTO et al.

Art Unit

2155

Examiner

K. DINH

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 52,763

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

Michele L. Connell

Typed or printed name

(202) 857-6000

Telephone number

October 27, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

ENOMOTO et al

Attorney Docket No. 101216-09002

Serial No.: 09/393,576

Group Art Unit: 2155

Filed: September 10, 1999

Examiner: K. Dinh

For: INTERNET INFORMATION DISPLAYING APPARATUS AND INTERNET
INFORMATION DISPLAYING METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

October 27, 2005

Sir:

The Applicant requests review of the Office Action mailed July 27, 2005, in the patent application identified above. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

REMARKS

Claims 23-31 are pending in the subject application. The outstanding Office Action is the second Office Action after the filing of a second RCE in this application. Thus, the application qualifies for Appeal.

In the outstanding Office Action, the Examiner rejected claims 23-27, 30 and 31 under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,898,819 to Austin et al. (hereinafter "Austin"), in view of U.S. Patent No. 5,491,781 to Gasperina (hereinafter, "Gasperina"). The Examiner rejected claims 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Austin in view of Gasperina and further in view of U.S. Patent No. 5,675,390 to Schindler (hereinafter, "Schindler").

The Applicant submits that these rejections are made in error for at least the reasons set forth below.

I. Claimed Limitations Not Met by Cited References

In the outstanding Office Action, the Examiner has cited references that do not meet all of the claimed limitations.

Independent claims 23 and 29 of the subject application recite, in part:

selecting (" , by a remote control," in claim 29)
an arbitrary button in said tool bar; and
magnifying only said selected button into a
predetermined size in longitudinal and lateral
directions and displaying said selected, magnified
button.

Independent claim 30 of the subject application recites, in part:

selecting an arbitrary button in said tool bar;
and
magnifying, in longitudinal and lateral
directions, and displaying the selected button upon a
single user action.

As noted above, in the outstanding Office Action, the Examiner rejected independent claims 23 and 30 under 35 USC § 103(a) as being unpatentable over Austin in view of Gasperina, and independent claim 29 under 35 U.S.C. §

103(a) as being unpatentable over Austin in view of Gasperina, and further in view of Schindler.

In making these rejections, the Examiner asserts that Austin teaches selecting a button, magnifying only the selected button, and displaying the selected, magnified button, in Fig. 2b thereof.

Fig. 2b of Austin merely illustrates “[a]n enlarged version of the preview button 58...” *Austin*, col. 7, lines 50-57. Austin teaches that the preview button 58 is a button that when selected, results in a color presentation shown in a presentation display area 52 of a screen 50 being automatically changed to a black and white version of the presentation. See, e.g., *id.* Austin neither discloses nor suggests that upon selecting the preview button 58, the preview button 58 is magnified and displayed, as asserted by the Examiner.

The Applicant submits that the Examiner’s assertion that Austin teaches the aforementioned limitations is an error based upon a clear factual deficiency in the rejections, and not a matter of interpretation. It is impossible to misinterpret the fact that Austin does not disclose or even suggest that selecting the preview button 58 results in magnifying the preview button, and displaying the magnified preview button. The Examiner’s assertion that, by providing the public with a drawing, i.e., Fig. 2b, of a close-up view of preview button 58, Austin teaches “selecting...an arbitrary button in said tool bar; and magnifying only said selected button into a predetermined size in longitudinal and lateral directions and displaying said selected, magnified button,” as recited in the pending claims, is a gross misrepresentation of the teachings of the reference, and not a matter of interpretation.

For at least this reason, the Applicant respectfully submits that all of the rejections based on this reference are improper, and withdrawal of such rejections is requested.

II. Omission of Essential Elements Needed for Prima Facie Rejection

In order for the Examiner to establish a prima facie case for obviousness, three (3) criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to those of ordinary skill in the art, to modify the primary reference as the Examiner proposes. Second, there must be a reasonable expectation of success in connection with the Examiner's proposed combination of the references. And third, the prior art references must disclose or suggest all of the claim limitations. MPEP 2143.

The following comments set forth the Examiner's omissions of one or more essential elements needed for a prima facie rejection.

A. The combination of cited references fails to disclose or suggest each and every element of the claimed invention.

The limitations of independent claims 23, 29 and 30 are not met by any of the cited references or combination thereof.

As explained above, Austin neither discloses nor suggests selecting an arbitrary button, and magnifying only said selected button...and displaying said selected, magnified button, as recited in claims 23 and 29.

As further described above, Austin neither discloses nor suggests selecting an arbitrary button, and magnifying...and displaying the selected button upon a single user action, as recited in claim 30.

The Applicant submits that neither Gasperina nor the combination of Gasperina and Schindler cures the deficiencies that exist in Austin. For example, neither Gasperina nor the combination of Gasperina and Schindler discloses or suggests selecting an arbitrary button, and magnifying only said selected button...and displaying said selected, magnified button, as recited in claims 23 and 29, or selecting an arbitrary button and magnifying...and displaying the selected button upon a single user action, as recited in claim 31.

For further arguments regarding the Gasperina and Schindler references, please see: Response filed March 11, 2004, at pp.2-5; Response filed October 14, 2004, at pp. 2-6; Response filed January 7, 2005, at pp. 8-9; and Response filed May 9, 2005, at pp. 8-9.

B. The Examiner has failed to show proper motivation for modifying the references applied in the rejections under 35 U.S.C. § 103(a).

In each of the rejections under 35 USC § 103, the Examiner failed to provide sufficient motivation for combining the references. In the Office Action, the Examiner merely stated that the motivation for combining the references is found in certain advantages stated by the Examiner (see, e.g., Office Action, p. 3, second paragraph; p. 5, first paragraph; pp.5-6, bridging paragraph). The Examiner, however, indicates nothing from within the applied references to evidence the desirability of the proposed combinations. This is an insufficient showing of motivation.

CONCLUSION

For all of the above reasons, review of the outstanding Office Action is respectfully requested, and a favorable decision, and allowance of all pending claims, are earnestly solicited.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Docket No. 101216-09002.**

Respectfully submitted,
ARENT FOX, PLLC



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